

REMARKS

In the Office Action¹, the Examiner rejected claims 1, 3, 4, 7-13, and 21-23 under 35 U.S.C. § 103(a) as unpatentable over admitted prior art in view of U.S. Patent No. 6,044,362 to Neely (“*Neely*”) and U.S. Patent Application Publication No. 2002/0062240 to Morinville (“*Morinville*”). Applicants respectfully traverse this rejection for the following reasons.

Because *Morinville* is a CIP of the ‘163 application, there is new matter present in *Morinville*. According to 37 C.F.R. § 1.104(c), the “pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.” It is not apparent what subject matter disclosed in *Morinville* qualifies for the priority date of the ‘163 application. Accordingly, the Examiner has the initial burden to show the pertinence of this reference in rejecting claims 1, 3, 4, 7-13, and 21-23, which includes identifying the subject matter relied upon by the Examiner in the rejections that is not new matter. The Examiner has not met this burden.

According to the M.P.E.P.,

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). M.P.E.P. § 2142, 8th Ed., Rev. 2 (May 2004), p. 2100-128.

The Examiner failed to meet the burden of factually supporting the § 103(a) rejection, as discussed below.

Initially, Applicants note that the Examiner failed to indicate how Applicants' admitted prior art, *Neely*, and *Morinville* apply to the specific features of the claims. Instead, the Examiner merely provided general allegations that the features of the claims would have been obvious, without addressing how the cited art applies to each and every feature of the claim (Office Action at pages 2-3). Indeed, the Examiner has failed to even discuss the specific claim limitations of both the independent and dependent claims (Office Action at pages 2-3).

The Examiner appears to be attempting to improperly shift the burden to Applicants to identify any potentially relevant passages from the references and respond accordingly. Applicants submit that such practice does not meet the requirements of 37 C.F.R. § 1.104(c), which requires the Examiner to explain the pertinence of each reference relied upon, and the requirements of M.P.E.P. § 706.02(j), which states that the examiner should set forth "the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s)." Furthermore, Applicants submit that such practice does not comply with M.P.E.P. § 706, which states that "[t]he goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest

opportunity.” Applicants, therefore, respectfully request that the rejection under Section 103 be withdrawn at least for this reason. In any event, to be fully responsive, Applicants provide the following remarks regarding the cited references. Should the Examiner continue to dispute the patentability of the claims, however, Applicants request a new non-final Office Action identifying where the cited reference(s) support such a position.

A *prima facie* case of obviousness has not been established because, among other things, none of Applicants’ admitted prior art, *Neely*, and *Morinville*, taken alone or in combination, teach or suggest each and every element recited by Applicants’ claims. Independent claim 1 recites, for example, a computer-implemented method for performing dispute handling in a system including a purchasing entity and a providing entity, including “receiving a response reflecting the first approver’s decision to dispute one or more line items included within the one or more invoices, wherein the first approver generates the first approver’s decision based on an indication that the one or more line items have been reviewed by one or more other approvers associated with the purchasing entity.”

Applicants’ specification identifies this subject matter as manifestly not taught by the prior art, stating: “[a]lthough such [prior art] services enable businesses to perform invoice processes electronically, dispute and payment processing is limited to the entire invoice. That is, if the purchaser disputed a particular line item within an invoice, the entire invoice would have to be disputed” (Specification at p. 3). *Neely* is consistent with the prior art as discussed in the specification. *Neely* states: “customer 20 may be

provided with any combination of the following options: 1) The customer may pay less than the amount due on the invoice ... for a specific reason such as a dispute concerning a line item contained on the invoice" (*Neely* col. 5, lines 4-9). *Neely* thus discloses disputing an entire invoice by not paying the full amount for the invoice, rather than the claimed "disput[ing] one or more line items included within the one or more invoices." Moreover, the claimed dispute is "based on an indication that the one or more line items have been reviewed by one or more other approvers associated with the purchasing entity," while *Neely* discusses only a "customer" which cannot correspond to both the claimed "first approver" and "one or more other approvers."

Morinville fails to cure the deficiencies of the admitted prior art and *Neely*.

Morinville discloses a system for approval of business processes where the approving managers are identified, and "[i]f two management levels are necessary for approval, the first level manager and the second level manager would be identified" (*Morinville*, ¶ 69). *Morinville*, however, fails to disclose that the first or second level managers are both involved in any way in a dispute of a line item on an invoice, and thus also fails to teach or suggest the claimed "receiving a response reflecting the first approver's decision to dispute one or more line items included within the one or more invoices, wherein the first approver generates the first approver's decision based on an indication that the one or more line items have been reviewed by one or more other approvers associated with the purchasing entity."

Accordingly, Applicants' admitted prior art, *Neely*, and *Morinville* fail to establish a *prima facie* case of obviousness with respect to claim 1, at least because the references

fail to teach each and every element of the claim. Claims 3 and 4 depend from claim 1 and are thus also allowable for at least the same reasons as claim 1.

Independent claim 7 recites, for example, a computer-implemented method for performing dispute handling in a system including a first processing entity and a second processing entity, including receiving an indication of a line item that has been disputed by a first person associated with the first processing entity and “receiving a response from the second processing entity reflecting whether the second processing entity approved the dispute of the line item” (emphasis added).

Again, Applicants’ specification identifies dispute processing of line items as not taught by the prior art, and *Neely*’s disclosure that “[a] customer may pay less than the amount due on the invoice ... for a specific reason such as a dispute concerning a line item” (*Neely* col. 5, lines 4-9) fails to rectify this deficiency. Even assuming the customer corresponds to the claimed “first processing entity,” *Neely* fails to disclose any response from a second processing entity regarding the dispute. *Neely* and Applicants’ admitted prior art, therefore, fail to teach or suggest the claimed “receiving a response from the second processing entity reflecting whether the second processing entity approved the dispute of the line item.”

Morinville’s disclosure of a system for approval of business processes where “the first level manager and the second level manager would be identified” (*Morinville*, ¶ 69) fails to cure the deficiencies of the admitted prior art and *Neely*. Even assuming the managers correspond to the claimed “first processing entity,” *Morinville* fails to disclose any response from a second entity regarding a dispute, much less a dispute regarding a

line item on an invoice. *Morinville* therefore also fails to teach or suggest the claimed “receiving a response from the second processing entity reflecting whether the second processing entity approved the dispute of the line item.”

Accordingly, Applicants’ admitted prior art, *Neely*, and *Morinville* fail to establish a *prima facie* case of obviousness with respect to claim 7, at least because the references fail to teach each and every element of the claim. Claims 8 and 9 depend from claim 7 and are thus also allowable for at least the same reasons as claim 7.

Moreover, claim 8 recites further subject matter not taught by the prior art of record. Claim 8 recites, “the computer-implemented method of claim 7, wherein receiving a response includes assigning the disputed line item to a resolving entity; and receiving an indication reflecting whether the resolving entity approved the dispute of the line item.” Applicants’ admitted prior art fails to discuss such a resolving entity, and *Neely* and *Morinville* both fail to cure this deficiency. Indeed, the Examiner has failed to identify any relevant teaching of the prior art that can reasonably be read to disclose this subject matter of claim 8.

Independent claim 10 recites, for example, a computer-implemented method for performing dispute resolution in a system including a providing entity and a purchasing entity, including “performing a dispute resolution process ... for line items in [a] first invoice that have not been approved by [a] first approver.”

Applicants’ specification at p. 3 identifies dispute resolution processing of line items as subject matter not taught by the prior art, and *Neely*’s disclosure that “[t]he customer may pay less than the amount due on the invoice ... for a specific reason

such as a dispute concerning a line item" (*Neely* col. 5, lines 4-9) fails to cure this deficiency. Even assuming the customer corresponds to the claimed "purchasing entity," *Neely* fails to disclose any dispute resolution process for line items. *Neely* and Applicants' admitted prior art, therefore, fail to teach or suggest the claimed "performing a dispute resolution process ... for line items in [a] first invoice that have not been approved by [a] first approver."

Morinville's disclosure that "the first level manager and the second level manager would be identified" (*Morinville*, ¶ 69) fails to cure the deficiencies of the admitted prior art and *Neely*. Even assuming the managers correspond to the claimed "first processing entity," *Morinville* fails to disclose a dispute resolution process related to line items on an invoice. *Morinville* therefore also fails to teach or suggest the claimed "performing a dispute resolution process ... for line items in [a] first invoice that have not been approved by [a] first approver."

Accordingly, Applicants' admitted prior art, *Neely*, and *Morinville* fail to establish a *prima facie* case of obviousness with respect to claim 10, at least because the references fail to teach each and every element of the claim. Claims 11 and 12 depend from claim 10 and are thus also allowable for at least the same reasons as claim 10.

Moreover, claim 12 recites further subject matter not taught by the prior art of record. Claim 12 recites, "the computer-implemented method of claim 11 [which depends from claim 10], wherein the dispute resolution process further includes: facilitating a direct resolution process between the providing entity and the purchasing entity when the response indicates that the providing entity did not approve the first

approver's dispute of the first line item." Applicants' admitted prior art fails to discuss such a dispute resolution process, and *Neely* and *Morinville* both fail to cure this deficiency. Indeed, the Examiner has failed to identify any relevant teaching of the prior art that can reasonably be read to disclose this subject matter of claim 12.

Independent claim 13 recites, for example, a computer-implemented method of performing a dispute resolution process between a providing entity and a purchasing entity, including "receiving a second notification reflecting whether disapproval of the entry has been approved by the providing entity."

Again, Applicants' specification at p. 3 identifies dispute processing of line items or individual entries in an invoice as subject matter not taught by the prior art, and *Neely*'s disclosure that "[t]he customer may pay less than the amount due on the invoice ... for a specific reason such as a dispute concerning a line item" fails to rectify this deficiency. Even assuming the customer corresponds to the claimed "purchasing entity," *Neely* fails to disclose any approval or disapproval of an entry by a providing entity. *Neely* and Applicants' admitted prior art, therefore, fail to teach or suggest the claimed "receiving a second notification reflecting whether disapproval of the entry has been approved by the providing entity."

Morinville's disclosure that "the first level manager and the second level manager would be identified" (*Morinville*, ¶ 69) fails to cure this deficiency. Indeed, *Morinville* discloses no approval or disapproval of entries involving a providing entity and a purchasing entity. *Morinville* therefore also fails to teach or suggest the claimed

“receiving a second notification reflecting whether disapproval of the entry has been approved by the providing entity.”

Accordingly, Applicants’ admitted prior art, *Neely*, and *Morinville* fail to establish a *prima facie* case of obviousness with respect to claim 13, at least because the references fail to teach each and every element of the claim.

Independent claim 21 recites, for example, a computer-implemented method for performing a dispute resolution process in a system including a purchasing entity and a providing entity, including “making the status [of a disputed line item] available to a second person of the providing entity.”

As discussed, Applicants’ specification identifies dispute processing of line items as subject matter not taught by the prior art. *Neely*’s disclosure that “the customer may pay less than the amount due on the invoice ... for a specific reason such as a dispute concerning a line item” (*Neely* col. 5, lines 4-9) fails to rectify this deficiency. Even assuming the customer corresponds to the claimed “purchasing entity,” *Neely* is directed toward processing entire invoices as a whole, and thus fails to disclose a line item in a disputed status, or making the status of such a line item available to a providing entity. *Neely* and Applicants’ admitted prior art, therefore, fail to teach or suggest the claimed “making the status [of a disputed line item] available to a second person of the providing entity.”

Morinville’s disclosure of a system for approval of business processes where “the first level manager and the second level manager would be identified” (*Morinville*, ¶ 69) fails to cure the deficiencies of the admitted prior art and *Neely*. Indeed, as *Morinville*

fails to disclose a purchasing entity or a providing entity, *Morinville* necessarily fails to disclose status of disputed line items or making such status available to a person of a providing entity. *Morinville* therefore also fails to teach or suggest the claimed "making the status [of a disputed line item] available to a second person of the providing entity."

Accordingly, Applicants' admitted prior art, *Neely*, and *Morinville* fail to establish a *prima facie* case of obviousness with respect to claim 21, at least because the references fail to teach each and every element of the claim. Claims 22 and 23 depend from claim 21 and are thus also allowable for at least the same reasons as claim 21.

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P

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By: 
for Jeffrey A. Berkowitz
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